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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/086,263	03/04/2002	Scott C. Nance	4248P2441	4043

7590 08/06/2004

Scott C. Nance  
10248 Slendor Ridge Avenue  
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EXAMINER

AMSBURY, WAYNE P

ART UNIT PAPER NUMBER

2171

DATE MAILED: 08/06/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

<p align="center"><b>Office Action Summary</b></p>	<p><b>Application No.</b></p> <p>10/086,263</p>	<p><b>Applicant(s)</b></p> <p>NANCE, SCOTT C.</p>	
	<p><b>Examiner</b></p> <p>Wayne Amsbury</p>	<p><b>Art Unit</b></p> <p>2171</p>	

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 20 May 2003.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-23 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-23 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 04 March 2002 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

CLAIMS 1-23 ARE PENDING

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

**Claims 1-15 and 21-23 are rejected under 35 U.S.C. 101** because the claimed invention is directed to non-statutory subject matter.

These claims are directed to abstract concepts, as opposed, for instance, to a computer-implemented method.

2. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

**Claims 4, 9, 20 and 21-23 are rejected under 35 U.S.C. 112, first paragraph,** as failing to comply with the enablement requirement. The claim(s) contains subject matter that was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention.

Claims 4 and 21-23 refer to a "phone book", but there is no support in the Disclosure for a physical, (printed), phone book, or a computerized phone book or any other variety, and the means to provide them. Claims 9 and 20 refer to items being "unpublished", but there is no support in the Disclosure for publishing in any of a variety of modes.

3. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

**Claims 4, 9, 20 and 21-23 are rejected under 35 U.S.C. 112, second paragraph**, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As noted above it is not clear what is intended by "phone book" or by "unpublished". In the interest of compact prosecution, it is assumed that publishing by any means, such as online or printed matter or imprinting on a computer-readable medium is intended.

4. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

**Claims 1 and 10** are rejected under 35 U.S.C. 102(e) as being anticipated by Czyszewski et al (Czy), US 6,728,346, 27 April 2004.

Czy is directed to user support of multifunction office devices, and in particular to supporting the use of users' contact information [COL 1 lines 33-44], stored as a database and searchable by a user [COL 3 lines 39-43].

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As to **claim 1**, the cellular phone number of user contacts is one piece of information to be found in the contact database [COL 13 lines 17-32]. The contacts comprise a list [COL 1 line 36 and elsewhere]. Clearly, such a contact list is compiled in order to create the database.

As to **claim 10**, Czy provides for searching the personal contacts [COL 3 lines 39-43] and teaches the use of dialing in reaching such information [COL 1 lines 46-60].

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

**Claims 2-9 and 11-23** are rejected under 35 U.S.C. 103(a) as being unpatentable over Czyszewski et al (Czy), US 6,728,346, 27 April 2004 in light of Talib et al (Talib), US 2001/0044837, 22 November 2001.

Czy does not explicitly teach that a directory is sorted in alphabetical order or made available as printed matter. Talib is directed to searching an information directory that combines the advantages of printed and on-line directories [0011].

**It would have been obvious** to one of ordinary skill in the art at the time of the invention to incorporate the teachings of Talib into the system of Czy because they would make the directory of Czy easy to search, drill down, drill up and drill across.

As to **claim 2**, see [006] of Talib.

As to **claim 3**, Talib provides for Internet access [0008].

As to **claim 4**, it is considered that the directory of Czy is a phone book, but to the extent that it is not, Talib teaches the printing of such directories.

As to **claim 5**, **Official Notice** is taken that it was well known at the time of the invention to provide directories, lists, and other such information in CD-ROM form. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide the directory of Czy on CD-ROM because a CD can be used to transport large amounts of data in an inexpensive, efficient computer-usable form that is not only less bulky than a printed version, but can be used with and searched by a PC.

As to **claim 6**, Talib teaches the use of advertising within directories [0006] and elsewhere.

As to **claims 7 and 8**, Talib provides the option of combining records from multiple databases [FIG 11, 15, 16 and corresponding text].

As to **claim 9**, the term "unpublished" corresponds to the commonly used: "unlisted". **Official notice** is taken that it was well known in the art at the time of the invention to provide for unlisted telephone numbers. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for unlisted cellular phone numbers because cellular phones are simply a category of phones, of which a portion are unlisted. To fail to do this would contradict common and desirable practice for the management of phone numbers.

As to **claim 11**, Czy provides for voice recognition [COL 5 lines 12-18].

As to **claim 12, Official Notice** is taken that the use of a person as a recognition service [Talib COL 2 line 59 and after] for phone directories was well known at the time of the invention. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide for a person to operate a phone directory because a person is more flexible than software in dealing with unusual problems.

As to **claims 13-15**, Talib provides for downloading to cell phones and PDA's, which are also computers [0026]

As to **claims 19-20, Official Notice** is taken that directory services provide information that no phone number exists for a given query and/or that they are unlisted. **It would have been obvious** to one of ordinary skill in the art at the time of the invention to provide this information because the expected response of a phone number cannot be given in these situations.

The elements of **claims 16-18 and 21-23** are rejected in the analysis above and these claims are rejected on that basis.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Wayne Amsbury whose telephone number is 703-305-3828. The examiner can normally be reached on M-TH 7-5.

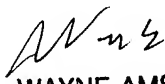
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Safet Metjahic can be reached on 703-308-1436. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.



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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

WPA

  
WAYNE AMSBURY  
PRIMARY PATENT EXAMINER